

PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number
20662-12164

Pursuant to 240 OG 45 and the *Legal Framework For EFS-Web*, I hereby certify that this follow-on correspondence is being officially submitted through the USPTO EFS-Web system from the Pacific Time Zone of the United States on the local date shown below.

on April 16, 2007Signature /Daniel R. Brownstone 46,581/Typed or printed
nameDaniel R. BrownstoneApplication Number
09/837,738Filed
April 16, 2001First Named Inventor
Steven BristowArt Unit
2614Examiner
Naghmeh Mehrpour

This request is being filed with a notice of appeal.

I am the

☐

applicant/inventor.

/Daniel R. Brownstone 46,581/
Signature☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

Daniel R. Brownstone
Typed or printed name☒

attorney or agent of record.

Registration number 46,581(415) 875-2358
Telephone number☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

April 16, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 of 1 forms is submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Steven Bristow *et al.*

SERIAL NO.: 09/837,738

FILING DATE: April 16, 2001

TITLE: Software and Protocol Structure For An Automated User Notification System

CONFIRMATION NO: 9746

EXAMINER: Naghmeh Mehrpour

GROUP ART UNIT: 2617

ATTY. DKT. NO.: 20662-12164

CERTIFICATE OF EFS-WEB TRANSMISSION			
Pursuant to 240 OG 45 and the <i>Legal Framework For EFS-Web</i> , I hereby certify that this follow-on correspondence is being officially submitted through the USPTO EFS-Web system from the Pacific Time Zone of the United States on the local date shown below.			
Signature:	/Daniel R. Brownstone 46,581/		
Typed or Printed Name:	Daniel R. Brownstone	Dated:	April 16, 2007

MAIL STOP AF
COMMISSIONER FOR PATENTS
P. O. BOX 1450
ALEXANDRIA, VA 22313-1450

REMARKS ACCOMPANYING REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

This application was filed on April 16, 2001, and included claims 1-100.

In an Office Action mailed on December 14, 2004, the Examiner made a requirement for restriction. Specifically, the Examiner stated that claims 1-29 and 51-79 (Group I) and 30-50 and 80-100 (Group II) were related as combination and subcombination. Therefore, concluded the Examiner, "restriction for examination purposes as indicated is proper."

Applicants elected Group I without traverse on January 7, 2005.

On January 13, 2005, Applicants filed a divisional application of this application. The application was assigned serial number 11/034,675 (“the ‘675 application”). The ‘675 application was filed with a preliminary amendment canceling claims 1-29 and 51-79, i.e. the claims pending in this application. Accordingly, the claims pending in the ‘675 application are only those that were designated as Group II in this application and subsequently canceled from this application. The preliminary amendment filed in the ‘675 application was received by the Office and is visible in PAIR.

On July 11, 2005, the Examiner issued an Office Action on the merits, rejecting the claims under 35 U.S.C. 102 and 103 as anticipated by or obvious in view of the Hoffman reference. The Office Action correctly identified the pending claims as 1-29 and 51-79. Applicants responded to the Office Action with an Amendment and accompanying Remarks on November 21, 2005. The Amendment did not add or remove any claims, i.e. claims 1-29 and 51-79 were still pending following the Amendment.

In the next Office Action of April 21, 2006, the Examiner issued a provisional obviousness-type double patenting rejection of claims 1-29 and 51-79 (Group I) in view of the pending divisional application. The rejection under Hoffman was not restated, and the Examiner indicated that “Applicant’s arguments with respect to claims 1-29, 51-79 have been considered but are moot in view of the new ground(s) of rejection.”

Applicants responded on July 21, 2006, pointing out that the double-patenting rejection was improper, since it was directed toward previously restricted claims filed in a divisional application.

In the Final Office Action of October 16, 2006, the Examiner did not address the pending claims (1-29 and 51-79). Instead, the Examiner indicated that claims 30-50 and 80-100 (which are not pending in this application) are rejected for statutory double-patenting over the ‘675 application.

In view of the above, Applicants now bring this Appeal.

35 U.S.C. 121 states, in part, that “a patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an

application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.” See also MPEP 804.01, describing the prohibition against double patenting rejections where a requirement for restriction has been made.

In this case, the Examiner has done precisely what the statute and the MPEP forbid, by issuing a double-patenting rejection in view of claims previously restricted out. Therefore, the obviousness-type double patenting rejection made on April 21, 2006 must be withdrawn.

Because the October 16, 2006 office action addresses only the canceled claims, it must also be withdrawn. See, e.g., MPEP 707.07(i). If the Examiner’s intention was to reject the pending claims rather than the canceled claims, the rejection would still be improper for the same reasons as those stated above with respect to the April 21, 2006 rejection.

Accordingly, as the only outstanding rejection in the application is improper, the Office is asked to withdraw that rejection and issue a Notice of Allowance for the pending claims, 1-29 and 51-79.

Respectfully submitted,
Steven Bristow *et al.*

Date: April 16, 2007

By: Daniel R. Brownstone 46,581/

Daniel R. Brownstone, Reg. No. 46,581
FENWICK & WEST LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
Tel: (415) 875-2358/Fax: (415) 281-1350
dbrownstone@fenwick.com